

IV. REMARKS

Status of the Claims

Claims 1 and 20 are amended. Claims 1-38 are presented for further consideration.

Summary of the Office Action

Claims 1-3, 9-22, and 28-38 stand rejected under 35USC102(e) on the basis of the cited reference Warmus et al, U.S. Patent No. 6,332,149. Claims 4-8, and 23-27 stand rejected under 35USC103(a) based on the reference Warmus, in view of the cited reference Dickmeyer, et al, U.S. Patent No. 6,413,100. The Examiner is respectfully requested to reconsider his rejections in view of the above amendments and the following remarks.

Discussion of the Cited Reference

The Examiner relies on the reference Warmus to support the rejection based on anticipation and as primary support for the rejection based on obviousness.

The reference Warmus is a system which allows the printing of books and similar documents with fixed and variable information within the book. The book is prepared as a template file divided into separate template pages for fixed information and separate template pages for variable information. The fixed information represents information that is the same on each copy of the book. The variable information changes from copy to copy, such as the name of an intended recipient of a particular copy. The template file is set up to identify which pages contain fixed or variable information and which area of a page will contain fixed or

variable information. (see column 10, lines 45-67). The Examiner's attention is directed to the fact that the files are divided by content without regard to format. There is no mention of converting the files to solution independent files, "devoid of any particulars unique to an originator of said complete book file", as described in the claims as amended.

The fixed content portion of the template file of Warmus is maintained as a separate file "stripped" of the variable content, while the variable content portion of the template file is maintained as another separate file "stripped" of the fixed content. The examiner likens this stripping step of Warmus to the conversion of the book file of this application to a solution-independent format. Applicant submits that this is not based on anything in the reference Warmus, as the cited reference is silent with respect to format conversion involving the removal of custom format data which may have been part of the original book file. Warmus at column 7, lines 6-10 indicates that in step 42 master and variable page files are created and these files contain:

"In addition, as noted in greater detail hereinafter, a press command file (also referred to as a "book ticket" file) is developed which specifies the manner in which data contained within the master and variable page files are to be merged to produce printed pages."

This "book ticket" file is likely to contain customized formatting data to generate a completed book or document that conforms to the style and processing of a particular publisher. Such a file is not a solution-independent file according to the claims of this application.

Further, the problem attempted to be solved in Warmus is a page file problem and treats the data files on a page by page basis, whereas the solution of the subject invention requires the processing of an entire book file. Warmus results in the customization of individual pages of a book during printing of multiple copies. In the system of this invention, all of the pages are processed in the same manner, with respect to content, while the entire book file may be transferred and converted to accommodate "solution dependent" needs of a particular provider.

In column 11, lines 10-29 of the reference Warmus, the purpose and use of the stripped working files is explained. The Examiner's attention is directed to the absence of a discussion of format or any changes therein. Based on this description, applicant submits that the process of Warmus is unrelated to the process and system of this application. The solution-independent and solution-dependent book files of the claims of this application are entirely different than the fixed and variable information page files of Warmus. The processing of the page files of Warmus causes an entirely different result than the processing of the book files in this application. Warmus allows the customization of pages of a book during a printing. This application allows the use of a book file by multiple different end providers. The books of Warmus have differing text. The books of this application will have the same text. Accordingly the cited reference Warmus does not support the rejection either based on anticipation or obviousness.

The Issue of Anticipation

The Examiner is reminded that the anticipation analysis requires

a positive answer to the question of whether the system of Warmus would infringe the claims of this application if it were later.

All of the claims of this application are directed to a method and system for reproducing books having the following features:

"a) receiving as a complete book file, including a book block, a digital representation, with customized formatting, of a book targeted for reproduction;
b) converting said complete book file to have a solution-independent, intermediate format, in a universal format, devoid of said customized formatting and any particulars unique to an originator of said complete book file;"

As explained above, the above features are not taught in the reference Warmus. Since these features are not present in the system of the reference Warmus, there can be no infringement of the subject claims. Therefore the teaching of Warmus does not support the rejection based on anticipation with respect to any of the claims.

Equivalent language appears in independent claim 20.

The Issue of Obviousness

It is well settled that in order to establish a *prima facie* case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application.

Applicant submits that the above described deficiencies of the primary reference Warmus are not remedied by the proposed combination with the teaching of the reference Dickmeyer. The combined references do not therefore support a *prima-facie* case

of obviousness. The modification of the teachings of Warmus or Dickmeyre, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.

The above arguments apply equally to the rejected dependent claims.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 24-0037.

Respectfully submitted,


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Reg. No. 44,004

27 JAN 2004

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